

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN O. ALLGEYER

Appeal No. 1998-2798
Application No. 08/645,144

ON BRIEF

Before CALVERT, MCQUADE, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2 to 4 and 6 to 11, all of the claims remaining in the application.

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The claims on appeal are drawn to an endotracheal tube, and are reproduced in the appendix of appellant's brief.¹

The references applied in the final rejection are:

Vilasi 1976	3,968,800	Jul. 13,
Adair 1994	5,329,940	Jul. 19,

An additional reference, of record, applied herein in a rejection pursuant to 37 CFR § 1.196(b) is:

Carden 1977	4,041,936	Aug. 16,
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Claims 2 to 4 and 6 to 11 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Adair in view of Vilasi.

With respect to independent claims 10 and 11, the basis of the rejection, as set forth on pages 3 and 4 of the examiner's answer, is:

Adair discloses an endotracheal tube for use with a fiberoptic or other intubating stylet

¹In reviewing the application, we note that the subject matter recited in claims 4, 8 and 9 is not shown in the drawings, as required by 37 CFR § 1.83(a). Also, the subject matter of claim 9 does not appear to have antecedent basis in the specification, as required by 37 CFR § 1.75(d)(1).

(fig. 5), comprising: a unitary tube (#12 of figs. 5, 9) with a proximal portion of generally constant cross section and a hole (22) situated on the distal end, whereby during use resistance in said unitary tube is not disclosed to be significantly increased.

The difference between Adair and new claim 10 is a tapered distal end.

Vilasi teaches and [sic] endotracheal tube (12) which includes a tapered distal end (44) as illustrated in fig. 1.

It would have been obvious to employ any well known endotracheal tube with the fiber optic bronchoscope of Adair including the endotracheal tube of Vilasi.

With respect to the claimed one or more holes, it is submitted that it is commonplace to employ at least one hole in the distal end of an endotracheal tube as taught by Adair (fig. 4) in order to provide a secondary opening to the interior of the endotracheal tube in the event that the distal end (16) becomes blocked.

* * * * *

New claim 11 appears to be substantially equivalent in scope to claim 10 and is included in Adair as modified by Vilasi for the reasons set forth above with respect to new claim 10.

After fully considering the record in light of the arguments presented in appellant's brief and the examiner's answer, we conclude that this rejection is not well taken.

First, we note that, contrary to the examiner's statement *supra*, the tapered distal end 44 of Vilasi is not a part of the endotracheal tube 12 per se, but rather constitutes tips

on each of the four legs 18, 20, 22, 24, which legs, through a disclosed mechanical arrangement, cause links 40 to pivot to the position shown in Fig. 2, thereby expanding tube 12. According to Vilasi's disclosure, tips 44, when made of a deformable material, may be readily shaped "to the configuration and contour of the opening into which the same are to be inserted so as to enable their ready and easy insertion into and removal from such opening" (col. 5, lines 30 to 34). Also, they "may be further deformed and shaped by the anesthetist to assure their smooth and easy entry into the glottic passageway" (col. 5, lines 65 to 68).

It is well settled that

[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In the present case, the apparatus disclosed by Adair includes an endotracheal tube 12 in which the balloon 18 is expanded by air pressure, rather than the tube being expanded by

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mechanical means, as disclosed by Vilasi. In our view, the fact that Vilasi discloses tapered, deformable members extending from the distal end of such mechanical means would not teach or suggest to one of ordinary skill providing a taper on the distal end of Adair's endotracheal tube, since, as previously noted, Vilasi's tapered members 44 are not on the tube, but are on the mechanical means, which is located within the tube. Thus, the most that Vilasi might teach or suggest would be the provision of tapered members on the distal end of a member located within the tube, rather than a tapered portion on the tube itself, as called for by the claims.

Accordingly, the rejection of claims 10 and 11, as well as the rejection of claims 2 to 4 and 6 to 9 dependent thereon, will not be sustained.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 2, 4 and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Carden in view of Adair. Carden discloses an endotracheal tube 10, for use with a fiberoptic bronchoscope 40, having a proximal portion 11 of generally constant cross section, and a distal portion (Fig. 2) including a balloon 16 thereon and a tapered end portion 19 disposed on the distal portion, configured as a truncated cone, and terminating in a ventilation opening 11a.² The only limitation in claims 2, 4 and 10 not disclosed by Carden is that the tube has "at least one additional opening disposed in or near said tapered end portion." However, Adair discloses an endotracheal tube 12 in which, in addition to end opening 16, an additional opening 22 is disposed near the end portion "which aids in the equal dispersion of oxygen into the lungs LL, RL" (col. 5, lines 17 to 20). In view of this

²We note that at page 14, lines 17 to 19 of the specification, appellant discloses that "The tapered end . . . could be, for example, a truncated conical section, with or without a generally cylindrical, short guide at the very tip of the taper." The apparatus disclosed by Carden has such a cylindrical, short guide portion 17.

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teaching of Adair of the desirability of including an additional opening near the distal end of an endotracheal tube, it would have been obvious to one of ordinary skill in the art to provide such an opening near the distal end of tube 10 of Carden.

In making this rejection we have reviewed the declaration under 37 CFR § 1.132 of Dr. Benumof (filed January 31, 1997), but do not consider it to be pertinent because it relates to the question of the obviousness of combining Adair and Vilasi, and does not refer to the tapered tube disclosed by Carden.

Conclusion

The examiner's decision to reject claims 2 to 4 and 6 to 11 is reversed. Claims 2, 4 and 10 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)
Administrative Patent Judge)
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JEFFREY V. NASE)	
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